In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 906

UNITED STATES OF AMERICA, PETITIONER

v.

BERT N. ADAMS, ET AL.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CLAIMS

MEMORANDUM IN OPPOSITION TO RESPONDENTS' MOTION THAT THE WRIT OF CERTIORARI BE DISMISSED AS IMPROVIDENTLY GRANTED

We note preliminarily that the argument advanced by respondents in support of their motion for a dismissal of the writ of certiorari was not presented in their brief in opposition to the government's petition. In any event, the argument is without merit.

Respondents' motion confuses two separate issues, each of which is governed by discrete standards. The issue raised by the petition is grounded upon respondents' assertion of patentability for a battery which substitutes material that the prior art recognized as capable of serving the same purpose (use

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as electrodes) as the elements used in a prior patented battery. It is the government's position that such a device is unpatentable, for 35 U.S.C. 103 specifically provides that—

> A patent may not be obtained * * * if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

The statements from the Court of Claims' papers referred to by respondents in their motion were made in connection with a second issue before the Court of Claims: Whether the Adams patent—assuming its validity—covered batteries constructed of material other than that referred to in the claims of the Adams patent. Respondents argued to the Court of Claims not only that the Adams battery (consisting of electrodes of magnesium and cuprous chloride) was patentable but that it also covered batteries consisting of silver chloride elements substituted for the cuprous chloride elements. Respondents thus sought to take advantage of the "doctrine of equivalents" in the construction of patent claims to extend the coverage of its claims to silver chloride batteries. The Court of Claims' rejection of this argument (which the government had opposed) has not been brought to the Court for review.

The doctrine of equivalents, as applied to the *scope* of patent claims, is an equitable doctrine designed to preclude the defeat of the patent protection by the

mere substitution of an equivalent for one of the elements recited in a claim. *Graver Mfg. Co.* v. *Linde Co.*, 339 U.S. 605, 608. However, an alleged invention of a limited nature in a crowded art—as is the situation here (Ct. of Cls. decision, Pet. App., p. 22)—is entitled only to a narrow range of equivalents. *Derby* v. *Thompson*, 146 U.S. 476; *Wright* v. *Yuengling*, 155 U.S. 47; *Texas Rubber & Specialty Corporation* v. *D. & M. Machine Works*, 81 F. 2d 206, 207, 208 (C.A. 5). Thus, the concept of equivalents, as applied to the scope of a patent's coverage, is different from the question whether a device is patentable where there has been merely a substitution of material known in the art to accomplish the purpose of material used in a prior patented device. It follows that there was no inconsistency in the two positions taken by the government below: (1) that the Adams battery was not patentable; (2) that the patent for the Adams battery, if it should be held valid, should be narrowly confined. However, even if the situation were otherwise, the presentation of alternative and inconsistent arguments would hardly constitute an estoppel.

It is respectfully submitted that the motion should be denied.

ARCHIBALD COX,
Solicitor General.

MAY 1965.

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